

REMARKS/AGRUMENTS

Reconsideration of this application as amended is respectfully requested.

The Examiner has objected to the specification.

The Examiner has objected to the abstract.

The Examiner has requested and IDS referencing the date of protocol UNI 3.1/4.0 and Q. 2931. Such IDS is provided, herewith.

The Examiner has rejected claims 1 and 3 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,519,261 to Brueckheimer, et al. (hereafter "Brueckheimer '261").

The Examiner has rejected claims 2, 4-6, and 11-12 under 35 U.S.C. § 103(a) as being unpatentable over Brueckheimer '261 in view of U.S. Patent No. 6,496,508 to Brueckheimer, et al. (hereafter, Brueckheimer '508).

The Examiner has rejected claims 7-10, and 13-14 under 35 U.S.C. §103(a) as being unpatentable over Brueckheimer '261 in view of Brueckheimer '508 in further view of U.S. Patent No. 6,490,245 to Burns, et al. (hereafter, Burns).

OBJECTIONS

The Examiner objected to the specification, referring to page 11, line 7 and page 12, line 19 in regard to UNI port 24 not being shown in Fig. 2. Applicant submits formal drawings, herewith illustrating UNI port 24 in Fig. 2.

The Examiner objected to the specification, referring to page 11, line 21. Appropriate correction has been made by amendment to the specification, above.

The Examiner objected to the abstract of the disclosure. Appropriate correction has been made by amendment to the abstract, above.

CLAIM REJECTIONS – 35 USC §102 (e)

The Examiner has rejected claims 1 and 3 under 35 U.S.C. §102(e) as being anticipated by Brueckheimer '261. Applicant submits that claims 1-3 are not anticipated by Brueckheimer '261. In regard to the rejection of claims 1 and 3, the Examiner has stated in part that:

Brueckheimer ('261) discloses, in reference to Fig. 1, a method comprising dynamically (col. 2, line 53-60), establishing ATM adaptation layer 2 (AAL-2) channel identifiers (CIDS) on a call-by-call basis, refer to abstract, col. 1 line 4-6, col. 1 line 44, col. 3 lines 25-26, using ATM standards-based call control signaling protocol (col. 5 line 65 – col. 6 line 9).

(5/6/03, Office Action, p 3)

Applicant respectfully submits that claims 1 and 3 are not anticipated by Brueckheimer '261. Claim 1 recites the feature of "... establishing AAL2 CIDs on a call-by-call basis using ATM standards – based call control signaling protocols." (Emphasis added) This feature is not disclosed by Brueckheimer '261. Infact, Brueckheimer '261's invention focuses on a specific physical implementation for an AAL2 switch requiring a specific chip suite and the method of interconnecting the chip suite. (Brueckheimer '261, col. 6, ll. 10-14). More specifically, Brueckheimer 261's invention lies within Layer 1 and Layer 2 of the 7 layer protocol stack. Thus, Brueckheimer '261 does not discuss call control, as claimed by applicant in claim 1. Although Brueckheimer '261 mentions connection control, he does not describe any method associated with the actual implementation of his connection control. (Brueckheimer '261, col. 8, ll. 39-43). Connection control in Brueckheimer '261 is only required as part of the firmware required to manage the inter chip virtual connection links. Because , Brueckheimer '261 does not disclose "establishing AAL2 CIDs on a call-by-call basis using ATM standards-based call control signaling protocols" as taught by claim 1, applicant respectfully submits that claim 1 and claim 2 which depends from claim 1, are not anticipated under 35 .S.C. § 102(e) by Brueckheimer '261.

The Examiner also rejected claim 3 under 35 U.S.C. §102(e) for the reasons set forth in the rejection of claim 1. Claim 3 discloses substantially similar limitations as claim 1 and recites

a node configured to dynamically establish ATM adaptation layer 2 (AAL2) channel identifiers (CIDs) on a call-by-call basis using ATM standards-based call control signaling protocols. (emphasis added). Because Brueckheimer '261 does not disclose this feature as taught by claim 3, applicant respectfully submits that claim 3 and claim 4, which depends from claim 3, are not anticipated under 35 U.S.C. §102(e) by Brueckheimer '261.

CLAIM REJECTIONS – 35 USC §103 (a)

The Examiner has rejected claims 2, 4-6, and 11-12 under 35 U.S.C. §103(a) as being unpatentable over Brueckheimer '261 in view of Brueckheimer '508. In regard to the rejection of claim 2 under 35 U.S.C. §103(a), the Examiner has stated in part that:

Brueckheimer '261 discloses the method of claim 1 further comprising translations (mapping) the CIDs to a local channel ID (virtual path/ virtual channel (VP/VC)), refer to col. 10, lines 19-21....

(5/6/03 Office Action, p. 4).

Applicant respectfully disagrees. Applicant submits that claims 1-4, 6, 8-10, 12, 14-15, 17-21, and 23 are not obvious in view of Brueckheimer '261 and Brueckheimer '508. It is respectfully submitted that it would be impermissible hindsight, based on applicant's own disclosure, to combine Brueckheimer '261 and Brueckheimer '508.

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

However, nowhere is there any indication that the references provide any motivation for the recited combination. Instead, it appears the teachings of the present application have been used as a blueprint to gather together and assemble various components of the prior art in the manner contemplated by applicant. This is a classic example of the use of hindsight reconstruction, and cannot properly be used as grounds for rejecting the present claims.

The U.S. Court of Appeals for the Federal Circuit has strongly criticized such applications of hindsight by specifically indicating that when an obviousness determination is made based upon a combination of references, even a patent examiner "must show reasons that the skilled artisan, confronted with the same problems as the inventor *and with no knowledge of the claimed invention*, would select the elements from the cited prior art references for combination in the manner claimed." *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998) (Emphasis added). Merely indicating, as the Examiner argues in his Office Action of May 6, 2003, that the claimed invention would be obvious to one of ordinary skill in the art based on the combination of the references is utterly inadequate. *Rouffet*, at 1357. Instead, what is needed is a showing of motivation, either from the references themselves or the knowledge of those of ordinary skill in the art, for the combination being relied upon. *Rouffet*, at 1357.

In the present case, there has been no showing of such motivation. Instead, the Examiner attempts to deconstruct the subject matter of the claims of the present application into its constituent components, states where each such component may be found in one of the cited references, and then concludes that it would have been obvious to combine the references to arrive at the claimed invention. This bare bones analysis is not sufficient to support a determination of obviousness of the present application. The burden is on the Examiner to show *why* one is so motivated as to come up with the combination being relied upon. *Rouffet*, at 1357-1358 ("If such a rote invocation could suffice to supply a motivation to combine, the more sophisticated scientific fields would rarely, if ever, experience a patentable technical advance. Instead, in complex scientific fields [an infringer or the Patent Office] could routinely identify the prior art elements in an application, invoke the lofty level of skill, and rest its case for [obviousness]. To counter this potential weakness in the obviousness construct, the suggestion to combine requirement stands as a critical safeguard against hindsight analysis and rote application of the legal test for obviousness.")

In regard to the rejection of claim 2, even if Brueckheimer '261 and Brueckheimer '508 were combined, such a combination would lack one or more features of claim 1 from which claim 2 depends. Claim 1 recites the feature of "... establishing AAL2 CIDs on a call-by-call basis using ATM standards-based call control signaling protocols." (Emphasis added) This feature is not disclosed by Brueckheimer '261. Infact, Brueckheimer '261's invention focuses on a specific physical implementation for an AAL2 switch requiring a specific chip suite and the method of interconnecting the chip suite. (Brueckheimer '261, col. 6, ll. 10-14). More specifically, Brueckheimer 261's invention lies within Layer 1 and Layer 2 of the 7 layer protocol stack. Thus, Brueckheimer '261 does not discuss call control, as claimed by applicant in claim 1. Although Brueckheimer '261 mentions connection control, he does not describe any method associated with the actual implementation of his connection control. (Brueckheimer '261, col. 8, ll. 39-43). Connection control in Brueckheimer '261 is only required as part of the firmware required to manage the inter chip virtual connection links. Nowhere does Brueckheimer '261 describe establishing AAL2 CIDs on a call-by-call basis using ATM standards-based call control signaling protocols as claimed by applicant's claim 1.

Nor does Brueckheimer '508 disclose "establishing AAL2 CIDs on a call-by-call basis using ATM standards-based call control signaling protocols." as claimed by applicant. Brueckheimer '508 describes the elimination of signaling demanded by UNI in the connection establishment procedure between narrowband and broadband networks. (Brueckheimer '508, col. 4, ll. 11-13). More specifically, Brueckheimer '508 describes the use of pre-provisioned connection identifiers, controlled by a connection broker. (Brueckheimer '508, col. 4, l. 21-col. 5, l. 48). Nowhere does Brueckheimer '508 even discuss AAL2 CIDs. Consequently, Brueckheimer '508 does not teach establishing AAL2 CIDs on a call-by-call basis using ATM standards-based call control signaling protocols, "as claimed by the applicant.

Thus, because neither, Brueckheimer '261 nor Brueckheimer '508 disclose applicant's claim 1, applicant respectfully submits that claim 1 is not obvious under 35 U.S.C. §103(a) by

Brueckheimer '261 in view of Brueckheimer '508. Given that claim 2 depends from claim 1, applicant respectfully submits that claims 1-2 are not obvious under 35 U.S.C. §103(a).

The Examiner also rejected claim 4 under 35 U.S.C. §103(a) for the reasons set forth in the rejection of claim 2. Claim 3 from which claim 4 depends, discloses substantially similar limitations as claim 1 and recites an ATM node configured to dynamically establish ATM AAL2 CIDs on a call-by-call basis using ATM standards – based call control signaling protocols. Because Brueckheimer '261, in view of Brueckheimer '508, does not disclose this feature and given that claim 4 depends from claim 3, applicant respectfully submits that claims 3-4 are not obvious under 35 U.S.C. §103(a) by Brueckheimer '261, in view of Brueckheimer '508.

The Examiner also rejected claims 5-6 under 35 U.S.C. §103(a) for the reasons set forth in the rejection of claim 2. Claim 5 from which claim 6 depends, discloses substantially similar limitations as claim 1 and recites mapping ATM AAL2 CIDs to a VP/VC within a standards-based call control protocol. Because Brueckheimer '261, in view of Brueckheimer '508, does not disclose this feature and given that claims 6-10 depend from claim 5, applicant respectfully submits that claims 5-10 are not obvious under 35 U.S.C. §103(a) by Brueckheimer '261, in view of Brueckheimer '508.

The Examiner also rejected claim 11 under 35 U.S.C. §103(a) for the reasons set forth in the rejection of claim 2. Claim 11 discloses substantially similar limitations as claim 1 and recites computer-readable instructions...to map ATM AAL2 CIDs to a VP/VC within a standard-based call control protocol. Because Brueckheimer '261, in view of Brueckheimer '508, does not disclose this feature and given that claims 12-14 depend from claim 11, applicant respectfully submits that claims 11-14 are not obvious under 35 U.S.C. §103(a) by Brueckheimer '261, in view of Brueckheimer '508.

The Examiner has rejected claims 7-10, and 13-14 under 35 U.S.C. §103(a) as being unpatentable over Brueckheimer '261 in view of Brueckheimer '508 in further view of Burns. In regard to the rejection of claim 2 under 35 U.S.C. §103(a), the Examiner has stated in part that:

Brueckheimer '261 and '508 discloses all the subject matter of the claimed invention with the exception of "network edge device communicatively coupled to customer premise equipment"

(5/6/03 Office Action, p. 5).

Applicant respectfully disagrees. Applicant submits that claims 7-10, and 13-14 are not obvious in view of Brueckheimer '261, Brueckheimer '508 and Burns. It is respectfully submitted that it would be impermissible hindsight, based on applicant's own disclosure, to combine Brueckheimer '261, Brueckheimer '508, and Burns.

In regard to the rejection of claims 7-10, even if Brueckheimer '261 and Brueckheimer '508 were combined, such a combination would lack one or more features of claim 5 from which claims 7-10 depend. Claim 5 recites the feature of "mapping ATM AAL2 CIDs to a VP/VC within a standards-based ATM call control protocol." (Emphasis added) This feature is not disclosed by Brueckheimer '261. Infact, Brueckheimer '261's invention focuses on a specific physical implementation for an AAL2 switch requiring a specific chip suite and the method of interconnecting the chip suite. (Brueckheimer '261, col. 6, ll. 10-14). More specifically, Brueckheimer 261's invention lies within Layer 1 and Layer 2 of the 7 layer protocol stack. Thus, Brueckheimer '261 does not discuss call control, as claimed by applicant in claim 5. Although Brueckheimer '261 mentions connection control, he does not describe any method associated with the actual implementation of his connection control. (Brueckheimer '261, col. 8, ll. 39-43). Connection control in Brueckheimer '261 is only required as part of the firmware required to manage the inter chip virtual connection links. Nowhere does Brueckheimer '261 describe mapping ATM AAL2 CIDs to a VP/VC within a standards-based ATM call control protocol as claimed by applicant's claim 5.

Nor does Brueckheimer '508 disclose "mapping ATM AAL2 CIDs to a VP/VC within a standards-based ATM call control protocol" as claimed by applicant. Brueckheimer '508 describes the elimination of signaling demanded by UNI in the connection establishment procedure between narrowband and broadband networks. (Brueckheimer '508, col. 4, ll. 11-13). More specifically, Brueckheimer '508 describes the use of pre-provisioned connection identifiers, controlled by a connection broker. (Brueckheimer '508, col. 4, l. 21-col. 5, l. 48). Nowhere does Brueckheimer '508 even discuss AAL2 CIDs. Consequently, Brueckheimer '508 does not teach mapping ATM AAL2 CIDs to a VP/VC within a standards-based ATM call control protocol as claimed by the applicant.

Nor does Burns disclose "mapping ATM AAL2 CIDs to a VP/VC within a standards-based ATM call control protocol" as claimed by applicant. Burns describes recovering from a signalling failure in a switched connection data transmission network. (Burns, title). More specifically, Burns describes a method shown in his Figure 3 for re-constructing connections after failure. (Burns, Fig. 3). Nowhere does Burns discuss mapping AAL2 CIDs. Consequently, Brueckheimer '508 does not teach mapping ATM AAL2 CIDs to a VP/VC within a standards-based ATM call control protocol as claimed by the applicant.

Thus, because neither, Brueckheimer '261 nor Brueckheimer '508 nor Burns disclose applicant's claim 5, applicant respectfully submits that claim 5 is not obvious under 35 U.S.C. §103(a) by Brueckheimer '261 in view of Brueckheimer '508 and further in view of Burns. Given that claims 6-10 depend from claim 5, applicant respectfully submits that claims 5-10 are not obvious under 35 U.S.C. §103(a).

The Examiner also rejected claims 13-14 under 35 U.S.C. §103(a) for the reasons set forth in the rejection of claims 7-10. Claim 11 from which claims 13-14 depend, discloses substantially similar limitations as claim 5 and recites computer-readable instructions...to map ATM AAL2 CIDs to a VP/VC within a standard-based call control protocol. Because Brueckheimer '261, in view of Brueckheimer '508, and further in view of Burns does not disclose this feature and given that claims 12-14 depend from claim 11, applicant respectfully submits that claims 11-14 are not obvious under 35 U.S.C. §103(a) by Brueckheimer '261, in view of Brueckheimer '508, and further in view of Burns.

Accordingly, Applicant respectfully submits that the Examiners objections, and rejections under 35 U.S.C. §102(e) and 35 U.S.C. §103(a) have been overcome by the amendments and the remarks and withdrawal of these objections and rejections is respectfully requested. Applicant submits that Claims 1-14 are now in condition for allowance and such action is earnestly solicited.

If there are any additional charges, please charge them to our Deposit Account No. 02-2666.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Date: Sept. 30th, 2003 Sanjeet K. Dutta
Sanjeet K. Dutta
Reg. No. 46,145

12400 Wilshire Blvd.
Seventh Floor
Los Angeles, CA 90025
(408) 947-8200